# IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

ROBERT J. SCHULLER, ET AL.

Serial No.:    10/609,446

Filed:  June 27, 2003

For:    FOOD PRODUCT SCALE-BASED INCENTIVE SYSTEM

Attorney Docket No.:   VCI 0430 PUS

Group Art Unit:  3622

Examiner:  Jeffrey D. Carlson

## REPLY BRIEF UNDER 37 C.F.R. § 41.41

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Sir:

This Reply Brief is in response to the Examiner's Answer mailed on December 24, 2009 for the above-identified patent application.

Applicants hereby incorporate the arguments presented in Applicants' Appeal Brief filed September 23, 2009.

1.    **Claims 1, 9 and 16 Are Separately Patentable Under 35 U.S.C. § 103(a) Over The Proposed Combination of *Hewitt* and *Sheehan***

Claim 1 is patentable over the proposed combination of *Hewitt* and *Sheehan*. Claim 1 is directed to, *inter alia*, an incentive system which includes a computerized checkout system that "automatically applies an appropriate price adjustment when a customer presents **both** the weighed item and the incentive item at checkout *as determined by* reading of both the product code for the weighed item and a product code for the incentive item" (emphasis added).

In *Hewitt*, the weighing scale 20 generates store coupons which can match certain items with certain products. For example, if a package of bagels is weighed, a coupon off of cream cheese will be generated. As another example, a coupon for a packet of cajun spices can be generated when shrimp or fish is weighed. If the customer wishes to receive the discount for the matching item (e.g., cream cheese or cajun spices), the customer must tear off the detachable portion 44 of the coupon in order for the coupon code to be scanned. (*Hewitt*, col. 5, ll. 5 – 27). As such, in *Hewitt*, the discount given to the customer is, at best, determined by reading (1) the product code of the matching product (e.g., the cream cheese or the cajun spices) for which the coupon is given and (2) the coupon code. In *Hewitt*, presentation of the weighed product (e.g., the bagels or the shrimp) is unrelated to applying the discount. The customer would receive the discount for the matching product even if the product code for the weighed product is not read (or the weighed product is not presented).

Claim 1, on the other hand, requires two inputs for an appropriate price adjustment to be applied: (1) the customer presents both the weighed item and the incentive item at checkout and (2) the application of the price adjustment is determined by the reading of both the *product code* for the weighed item and the *product code* for the incentive item. The Examiner states that "there is no requirement that a customer must present both [items] in the claims." (Ex. Ans., p. 10). Contrarily, claim 1 specifically recites that the

- 2 -

computerized checkout system automatically applies an appropriate price adjustment "...*as determined by* reading of *both* the product code for the weighed item and a product code for the incentive item" (emphasis added). Accordingly, both the weighed item and the incentive item must be presented and the product code for the weighed item and the product code for the incentive item must be read in order for the price adjustment to be applied. The Examiner also states that "[a]s long as a single customer *presents* both (as most/all would tend to do), then the claims are certainly met" (emphasis added, Ex. Ans., p. 11). Claim 1, however, requires a presentation of the weighed product and the incentive product **and** a reading of the product codes for both items. The Examiner has failed to address at least one aspect of claim 1. Namely, that the claim also requires reading the product codes for both items for a price adjustment to be applied.

*Sheehan* does not make up for the deficiency in *Hewitt*. As such, claim 1 is patentably distinct over the proposed combination of *Hewitt* and *Sheehan*.

Claim 9 is directed to, *inter alia*, an incentive system which includes a computerized checkout system that "automatically applies an appropriate price adjustment when a customer presents *both* the weighed item and the incentive item at checkout *as determined by* input of both the product identifier for the weighed item and a product identifier for the incentive item" (emphasis added). The proposed combination of *Hewitt* and *Sheehan* fails to teach the limitations of claim 9 for the same reasons set forth above with respect to claim 1. Specifically, *Hewitt* does not teach (1) that a price adjustment is applied when a customer presents both the weighed item and the incentive item at checkout and (2) that application of the price adjustment is determined by input of both the product identifier for the weighed item and the product identifier for the incentive item. Furthermore, *Sheehan* does not make up for the difference. As such, claim 9 is patentably distinct over the proposed combination of *Hewitt* and *Sheehan*.

Claim 16 is directed to, *inter alia*, an incentive system which includes a computerized checkout system that "automatically applies an appropriate price adjustment when a customer presents *both* the packaged, random weight food product and the incentive

item at checkout *as determined by* input of both the store-selected product code for the packaged, random weight food product and a product code for the incentive item" (emphasis added). The proposed combination of *Hewitt* and *Sheehan* fails to teach the limitations of claim 16 for the same reasons set forth above with respect to claim 1. Specifically, *Hewitt* does not teach (1) that a price adjustment is applied when a customer presents both the packaged, random weight food product and the incentive item at checkout and (2) that application of the price adjustment is determined by input of both the store-selected product code for the packaged, random weight food product and the product code for the incentive item. Furthermore, *Sheehan* does not make up for the difference. As such, claim 16 is patentably distinct over the proposed combination of *Hewitt* and *Sheehan*.

For at least these reasons, claims 1, 9 and 16 are patentable over the proposed combination of *Hewitt* and *Sheehan*. Applicants kindly request the Examiner to withdraw the rejection with respect to claim 1 (and dependent claims 2-6), claim 9 (and dependent claims 10-15), and claim 16 (and dependent claim 17).

2. **Claim 18 Is Separately Patentable Under 35 U.S.C. § 103(a) Over The Proposed Combination of *Hewitt* and *Sheehan***

Claim 18 recites that the incentive system includes a scale which, in connection with a weighing operation of an item, prints incentive identifying information for a plurality of incentive items based on a weighed item along with a single incentive code. The claim further recites that the single incentive code is used to identify the plurality of incentive items that are based on the weighed item. The Examiner agrees that *Hewitt* fails to teach a single code being used to identify a plurality of incentive items. (Ex. Ans., p. 12). The Examiner maintains, however, that *Sheehan* makes up for the difference. *Sheehan*, however, merely teaches that a swipe of a club card or a check of a centralized database allows all appropriate electronic coupons to be processed. There is no teaching in *Sheehan* that the electronic coupons accessed via the club card or the centralized database (assuming either has an associated single incentive code) are based on a weighed product. Thus, *Sheehan* does not disclose a single incentive code used to identify a plurality of incentive items that are based on a weighed item as recited in claim 1.

Furthermore, there is no reason to combine *Hewitt* with *Sheehan* in the manner proposed by the Examiner. *Hewitt* discloses a paper coupon dispensing system for dispensing paper coupons based on the weighing of an item. (Col. 5, ll. 1-25). The sales messages are pre-programmed and the labels including these sales messages are printed for placement on the purchased product. (Col. 4, ll. 34 – col 5, ll. 19). *Sheehan* discloses an electronic database of coupons for redemption by a customer using a club card at a point-of-sale terminal. (Paragraph 0019). Based on the disparate forms of incentive dispensing systems disclosed in these references, one of ordinary skill in the art would not have a reason to combine these references in a manner suggested by the Examiner. For instance, if a customer is given a coupon having the discounting information for the incentive product(s) which is attached to the weighed product (as taught in *Hewitt*) and, at the point of purchase, uses a club card to receive the discount for the incentive products (as taught in *Sheehan*), either one of the benefits of each respective reference will be effectively destroyed. Furthermore, a benefit disclosed in *Sheehan* of the disclosed system is to eliminate the use of "bulky, troublesome, and generic traditional coupons." (¶ [0018]). Thus, what *Hewitt* promotes as a purpose of the disclosed system (i.e., generating paper coupons) is contrary to the purposes disclosed in *Sheehan* (i.e., using electronic coupons). For at least these reasons, one of ordinary skill would not combine the references in the manner suggested by the Examiner.

Respectfully submitted,

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